

## **REMARKS**

### **I. Introduction**

With the cancellation herein without prejudice of claim 2 and the addition of new claims 11 to 21, claims 1 and 3 to 21 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority. As regards the certified copy of the priority document, the Examiner will note that filed herewith is a certified copy of Application No. 101 08 204.5, filed in the Federal Republic of Germany on February 21, 2001, from which the present application claims priority. Applicant respectfully requests acknowledgment of receipt of the certified copy of the priority document in the next Office communication.

### **II. Rejection of Claims 1 to 10 Under 35 U.S.C. § 112**

Claims 1 to 10 were rejected under 35 U.S.C. § 112, second paragraph as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of the invention. This rejection is not readily understood because the Office Action first contends that there is insufficient antecedent basis for the phrase "and a holographic recording of at least one of the measuring object and the reference object," Office Action at p. 2, but then states that "[t]echnically speaking, there is no antecedent basis problem with 'a holographic recording,'" Office Action at p. 2. The Office Action then states that "the single claim appears to try to encompass both embodiments of the invention as depicted in Figures 1 and 2 of the specification" and that "[t]his language makes the claim unclear as to what method is exactly being claimed, and therefore makes the claim confusing to one of ordinary skill in the art." Office Action at p. 2.

Applicant respectfully disagrees with the merits of this rejection, to the extent that the present rejection is understood, and respectfully submits that claims 1 to 10 fully comply with the requirements of 35 U.S.C. § 112, second paragraph, which merely requires that the "claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." M.P.E.P. § 2173.02 (emphasis added). Indeed, alternative expressions are permissible and not

indefinite under 35 U.S.C. § 112, second paragraph. M.P.E.P. § 2173.01

("Applicant may use . . . alternative expressions . . . or any other style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought").

Notwithstanding the foregoing, the Examiner will note that claim 1 has been amended herein without prejudice to delete the allegedly confusing language. Claim 2 has been canceled herein without prejudice or waiver. It is therefore respectfully submitted that claims 1 and 3 to 10 fully comply with the requirements of 35 U.S.C. § 112, and withdrawal of this rejection is therefore respectfully requested.

### **III. New Claims 11 to 20**

New claims 11 to 21 have been added herein. It is respectfully submitted that new claims 11 to 21 do not add any new matter and are fully supported by the present application, including the Specification.

Claims 11 to 20 include limitations analogous to claims 1 to 10 but are directed to the alternative deleted from claim 1. It is respectfully submitted that claims 11 to 20 are allowable as presented.

Claim 21 includes limitation analogous to claim 9. It is therefore respectfully submitted that claim 21 is allowable as presented.

### **IV. Allowable Subject Matter**

Applicant notes with appreciation the indication that claim 1 "may be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph." Office Action at p. 2. In view of all of the foregoing, it is respectfully submitted that the rejection of claim 1 under 35 U.S.C. § 112, second paragraph has been obviated and that claim 1 is in condition for immediate allowance. Since claims 3 to 10 and 21 ultimately depend from claim 1, it is respectfully submitted that these dependent claims are also in condition for immediate allowance.

**V. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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